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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/784,284

02/16/2001

John Ricci

1065.26 (B)

3054

7590

05/04/2005

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EXAMINER

BLANCO, JAVIER G

ART UNIT

PAPER NUMBER

3738

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/784,284  
Filing Date: February 16, 2001  
Appellant(s): RICCI ET AL.

MAILED  
NOV 04 2000  
Group 0700

John Ricci, Harold Alexander, Harriett Naiman, and Bruce L. Hollander  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed May 13, 2004.

Art Unit: 3738

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

(1) With regards to claims 5, 9, 14, 18, and 19, which are on Appeal and have been rejected under 35 U.S.C. 102(b) as being anticipated by Branemark et al. (US 4,330,891), the appellant's statement of the issues in the brief is correct. Although the appellant's statement is correct, the examiner hereby withdraws said rejection in view of appellant's persuasive arguments.

(2) With regards to claims 5, 7, 9, and 12-19, which are on Appeal and have been rejected under 35 U.S.C. 102(e) as being anticipated by Naiman et al. (US 5,607,607), the appellant's statement of the issues in the brief is correct.

Art Unit: 3738

(3) With regards to claims 5, 7, 9, 14-16, and 19, which are on Appeal and have been rejected under 35 U.S.C. 103(a) as being unpatentable over Lin et al. (US 4,778,469) in view of Mears (US 4,553,272), the appellant's statement of the issues in the brief is correct. Although the appellant's statement is correct, the examiner hereby withdraws said rejection in view of appellant's persuasive arguments.

**(7) *Grouping of Claims***

Appellant's brief includes a statement that claims 5, 7, 9, and 12-19 may be grouped together and may be presumed that in regard to patentability that the Appealed claims stand or fall together.

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

4,330,891	Branemark et al.	5-1982
5,607,607	Naiman et al.	
4,778,469	Lin et al.	10-1988
4,553,272	Mears	11-1985

**(10) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

(1) Claims 5, 7, 9, and 12-19 were rejected under 35 U.S.C. 102(e) as being anticipated by Naiman et al. (US 5,607,607). This rejection is set forth in a prior Office Action (Final Office Action), mailed on January 2<sup>nd</sup>, 2003.

Art Unit: 3738

**(11) *Response to Argument***

With respect to Naiman et al. '607, Applicants filed a Declaration under 37 C.F.R. 1.131 and an Expert Opinion under 37 C.F.R. 1.132. As already mentioned during the Final Office Action, mailed on January 2<sup>nd</sup>, 2003:

(a) The inventive entity in Naiman et al. '607 is different from the inventive entity of the present application (09/784,284) and US 6,419,491.

(b) The Declaration under 37 C.F.R. 1.131 and the Expert Opinion under 37 C.F.R. 1.132 fail to provide proof of conception and reduction to practice of the invention claimed herein prior to the effective filing date of Naiman et al. '607. The invention claimed herein is an orthopedic implant comprising an implant element having a micro-geometric, repetitive surface pattern of a multiplicity of alternating ridges and grooves with an established width of about 2 to about 25 microns, and an established depth of about 2 to about 25 microns. Said micro-geometric repetitive pattern defines a guide to promote the rate, orientation, and direction of growth of colonies of cells.

For the above reasons, it is believed that the rejections should be sustained.

Art Unit: 3738

Respectfully submitted,

A stylized handwritten signature consisting of two large, overlapping loops, resembling the letters 'JB'.

Javier G. Blanco  
April 28, 2005

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